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10/712,333	11/13/2003	Kaoru Koike	09792909-5759	1181

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EXAMINER

COLEMAN, WILLIAM D

ART UNIT

PAPER NUMBER

2823

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/712,333

Applicant(s)

KOIKE ET AL.

Examiner

W. David Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 39-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 39-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 10/080,104.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

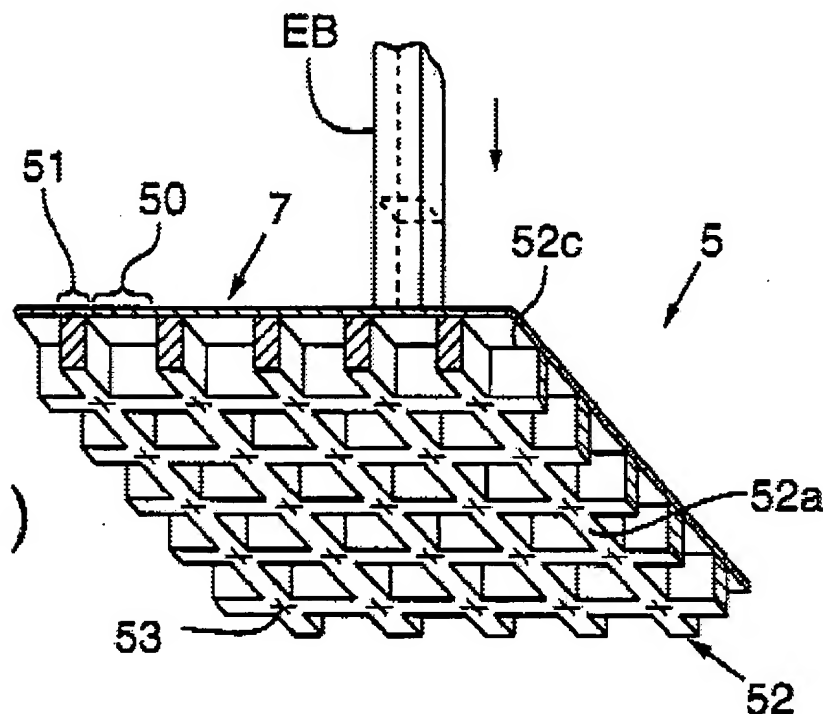
3. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Yahiro et al., U.S. Patent 6,204,509 B1.

Yahiro discloses the invention as claimed. See **FIGS. 1(a)-12**, where Yahiro teaches the claimed limitations.

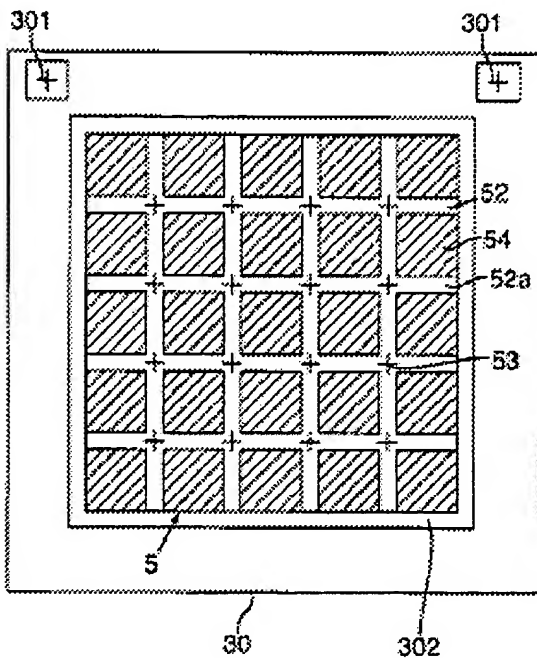
4. Pertaining to claim 1, Yahiro teaches a mask-making member comprising: a plurality of pattern formation regions **50** in which mask circuit patterns are to be formed; and a supporting region **51** in which any mask circuit pattern is not to be formed, said supporting region being provided for holding said plurality of pattern formation regions while separating said plurality of pattern formation regions from each other;

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wherein said supporting region has first alignment marks **53** used at the time of exposure of a mask made from said mask-making member for forming said mask circuit patterns thereon, and second alignment marks **301** used at the time of exposure of a substrate to be exposed for forming circuit patterns thereon.



5. Pertaining to claim 2, Yahiro teaches a mask-making member according to claim 1, wherein said first alignment marks are formed in such a manner that one-or more of said first alignment marks **53** are located in a portion, around each of said plurality of pattern formation regions, of said supporting region, and said second alignment marks **301** are formed in such a manner as to be all located in a portion, outside an area formed by said plurality of said pattern formation regions, of said supporting region.



6. Pertaining to claim 3, Yahiro teaches a mask-making member according to claim 1, wherein shapes of said first alignment marks are different from those of said second alignment marks (please note that the Examiner takes the position that second alignment marks 301 have a rectangular shape around a cross-hair).

7. Pertaining to claim 4, Yahiro teaches a mask-making member according to claim 1, wherein said mask making member is a transmission mask-making member (well known when using a electron beam lithography technique).

8. Pertaining to claim 5, Yahiro teaches a mask-making member according to claim 1, wherein said mask making member is a stencil mask-making member (please note that the transfer of the image is a stencil type process).

9. Pertaining to claim 6, Yahiro teaches a mask-making member according to claim 4, wherein said first alignment marks and said second alignment marks are formed on an electron scatterer formed on a membrane.

10. Pertaining to claim 7, Yahiro teaches a mask-making member according to claim 4, wherein said first alignment marks and said second alignment marks are formed on an electron scatterer formed on a membrane by selectively removing said electron scatterer.

11. Pertaining to claim 8, Yahiro teaches a mask-making member according to claim 5, wherein said first alignment marks and said second alignment marks are formed on a mask board.

12. Pertaining to claim 9, Yahiro teaches a mask-making member according to claim 5; wherein said first alignment marks and said second alignment marks are formed on a mask board by selectively removing said mask board. (please note that the claims presented are product claims and not process claims and only patentable weight is given to the product).

13. Pertaining to claim 10, Yahiro teaches a mask-making member according to claim 5, wherein said first alignment marks and said second alignment marks are formed on a mask board by selectively removing said mask board to form holes or grooves in said mask board, and burying said holes or grooves in said mask board, and burying said holes or grooves with a metal

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whose atoms have atomic weights heavier than those of atoms of said mask board (please see the reasoning to the rejection of claim 9 above).

14. Pertaining to claim 11, Yahiro teaches a mask-making member according to claim 10, wherein said metal is platinum, gold, silver, copper, tungsten, tantalum, or molybdenum (column 8, line 18).

15. Pertaining to claim 39, Yahiro teaches a mask comprising:  
a plurality of pattern formation regions in which mask circuit patterns are formed; and  
a supporting region in which any mask circuit pattern is not formed, said supporting region being provided for holding said plurality of pattern formation regions while separating said plurality of pattern formation regions from each other; wherein said supporting region has first alignment marks used at the time of exposure of said mask for forming said mask circuit patterns thereon, and second alignment marks used at the time of exposure of a substrate to be exposed for forming circuit patterns thereon.

16. Pertaining to claim 40, Yahiro teaches a mask according to claim 39, wherein said first alignment marks are formed in such a manner that one or more of said first alignment marks are located in a portion, around each of said plurality of pattern formation regions, of said supporting region, and said second alignment marks are formed in such a manner as to be all located in a

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portion, outside an area formed by said plurality of said pattern formation regions, of said supporting region.

17. Pertaining to claim 41, Yahiro teaches a mask according to claim 39, wherein shapes of said first alignment marks are different from those of said second alignment marks.

18. Pertaining to claim 42, Yahiro teaches a mask according to claim 39, wherein said mask is a transmission mask.

19. Pertaining to claim 43, Yahiro teaches a mask according to claim 39, wherein said mask is a stencil mask.

20. Pertaining to claim 44, Yahiro teaches a mask according to claim 42, wherein said first alignment marks and alignment marks and second alignment marks are formed on an electron scatterer formed on a membrane.

21. Pertaining to claim 45, Yahiro teaches a mask according to claim 42, wherein said first alignment marks and said second alignment marks are formed on an electron scatterer formed on a membrane by selectively removing said electron scatterer.

22. Pertaining to claim 46, Yahiro teaches a mask according to claim 43, wherein said first alignment marks and said second alignment marks are formed on a mask board.



23. Pertaining to claim 47, Yahiro teaches a mask according to claim 43, wherein said first alignment marks and said second alignment marks are formed on a mask board by selectively removing said mask board.

24. Pertaining to claim 48, Yahiro teaches a mask according to claim 43, wherein said first alignment marks and said second alignment marks are formed on a mask board by selectively removing said mask board to form holes or grooves in said mask board, and burying said holes or grooves with a metal whose atoms have atomic weights heavier than those of atoms of said mask board.

25. Pertaining to claim 49, Yahiro teaches a mask according to claim 48, wherein said metal is platinum, gold, silver, copper, tungsten, tantalum, or molybdenum.

***Information Disclosure Statement***

26. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### *Drawings*

27. Figures 1 and 2 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Applicants indicated that revised drawings have been submitted, however the Examiner is requesting a resubmission including figure 2.

### *Double Patenting*

28. Claim 1 of this application conflict with claim 1 of Application No. 11/103,809. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

29. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

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filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

30. Claim 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of copending Application No. 11/103,809. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### *Conclusion*

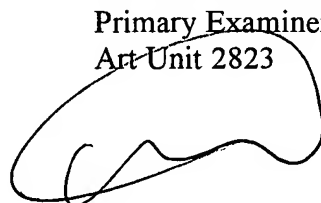
31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. David Coleman whose telephone number is 571-272-1856.

The examiner can normally be reached on Monday-Friday 9:00 AM - 5:30 PM.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 571-272-1855. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

W. David Coleman  
Primary Examiner  
Art Unit 2823



WDC